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Paper No. 42

JOEL ROSENBLATT
445 11TH AVE
INDIALANTIC FLORIDA 32903

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In re Application of:
Addington et al.
Application No.: 09/396,531
Filed: September 15, 1999
Attorney Docket No.: 99-1001

OFFICE OF PETITIONS
DECISION DENYING PETITION

This is a decision on the petition filed by facsimile transmission October 8, 2003, which is being treated as a petition under 37 CFR 1.181(a)(3) requesting *inter alia* that the decision of the Director of Technology Center 3700 (Technology Center Director) mailed on October 2, 2003 be vacated.

The petition to vacate the decision of the Technology Center Director dated October 3, 2003, is **denied**.

OPINION

Petitioners seek vacatur of the Technology Center Director's decision of October 2, 2003, on the ground that the decision demonstrates unfair bias and prejudice towards applicants, such that they did not receive a fair and impartial review of their petition of June 26, 2003.¹

Petitioners assert that because the Technology Center Director's decision failed to address, directly or indirectly, the examiner's improper remarks that had been made in the final Office action, the decision lacks adequate grounding in the facts of record and an adequate explanation or reasons in support of the decision. Inspection of applicants' petition of June 26, 2003, reveals that petitioners (at 2-3) quoted 11 statements made by the examiner of which petitioners complained and specifically identified where in the examiner's final office action the statements were located, in support of their request for expungement of that action. Both the contents of the petition and the actual statements made in the final Office action were part of the contents of this file when the Technology Center Director rendered her decision. As the record shows that the Technology Center Director agreed with petitioners' complaint about the contents of the final Office action and concluded that those statements could not properly remain part of the administrative record of this file, it is not seen how the Technology Center Director did not, directly, or indirectly, address the examiner's

¹ In accordance with petitioners' request in paragraph 7 of the instant petition, review will be limited to this ground and will exclude from review the merits of patent examination by the examiner, and the alleged bias and prejudice demonstrated by the examiner, as asserted in connection with the asserted prejudice by the Technology Center Director.

statements of which petitioners complained. Furthermore, as the Technology Center Director favorably considered the remedy requested by petitioners, it is not seen that the Technology Center Director's decision should have further burdened the record with a more specific mention of the content or nature of the examiner's statements, particularly given petitioners' specific request to expunge the record of such statements.

Petitioners further assert that as the examiner's prejudicial statements are inextricably part of the examiner's rejections of the claims, it is not possible to separate any of the prejudicial statements from the facts or reasons given for the rejections of the claims. This contention is unpersuasive inasmuch as the Technology Center Director has vacated the former Office action with a directive to expunge that Office action from the record and has further instructed the examiner to issue an Office action "containing the substantive matters set forth in the June 18, 2003, [Office action] but omitting any personal comments directed to either applicants or their counsel." Moreover, the record shows that the Technology Center Director considered whether the outstanding rejection of the claims was improperly influenced by any alleged bias or prejudice by the examiner and concluded that it was not. In this regard, the record shows that the Technology Center Director, after conducting a thorough review of the prosecution history of the instant application, relied upon the fact that the primary reference applied in the office action (Fowble) has been consistently applied throughout the prosecution history.

Petitioners further point to several statements in the Technology Center Director's decision that petitioners assert lack "record fact" and demonstrate the Technology Center Director's "hostility and bias towards petitioners." The use of the term "frustration" on the part of the Technology Center Director in the decision of June 26, 2003, is not an indication of hostility or bias on the part of the Technology Center Director. See Novomax Technologies, Inc. v. Southern Industrial Chemicals, Inc., 199 U.S. App. LEXIS 5800 at *7 (Fed. Cir. March 31, 1999) (Federal Circuit description of district court judge as "frustrated" not intended as either hostile or derogatory). Nothing in the record suggests that the Technology Center Director's use of the term "frustration" was meant to be hostile or derogatory.

Furthermore, the Technology Center Director has granted petitioners' request that Office action of which petitioners complained be vacated and expunged from the record, and has further directed that action be replaced with an Office action lacking any personal comments directed either to applicants or counsel of record. Such does not support petitioners' contention that the Technology Center Director has hostility or bias towards petitioners. While the Technology Center Director did not also favorably consider petitioners' request that the examination of this application be removed from Technology Center 3700, that does not demonstrate that petitioners did not receive a fair and impartial review of their petition. The Technology Center Director has required counseling of the examiner by his supervisor with respect to the proper content of Office actions, and has also indicated that applicants have the option of filing a reply to the forthcoming Office action or of further pursuing their appeal.

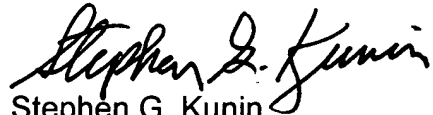
As noted in In re Ovshinsky, 24 USPQ2d 1241, 1251-2 (Comm'r Pats.1992), the issue is not whether the perceptions of an applicant and his representative regarding alleged bias are reasonable; rather the issue is: whether an applicant has demonstrated improper conduct, including bias or the appearance of bias, on the part of the Technology Center Director. For the reasons set forth above, the record does not demonstrate bias or the appearance of bias towards applicants or their representative by the Technology Center Director.

The petition is granted to the extent that the decision of the Technology Center Director

dated October 2, 2003, has been reviewed, but is **denied** as to the request that the aforementioned decision be vacated.

This application is being returned to Technology Center 3700 for further processing.

Telephone inquiries related to this decision should be addressed to Petitions Examiner Brian Hearn at (703) 305-1820.

A handwritten signature in black ink, appearing to read "Stephen G. Kunin". The signature is fluid and cursive, with the first name "Stephen" being more prominent.

Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy

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